

REMARKS/ARGUMENTS

Summary of Rejection Over Prior Art

Claims 2-11, 13, 16-19, 21-30, and 35-39 have been rejected under 35 USC 103(a) as being obvious over Kiewit in view of Thomas. Reconsideration and withdrawal of this rejections are respectfully requested in in light of the following remarks.

Patentability of claims over Kiewit and Thomas

With respect to independent apparatus claim 2, the Examiner concedes that "Kiewit does not disclose the broadcast program is transmitted by the programming signal source in combination with a surveying code, and the stationary means further comprises third detecting means for detecting said surveying code and associating said surveying code with said identification signals." However, the Examiner contends that this gap is bridged by Thomas. Issue is respectfully taken with the Examiner in this regard.

Thomas discloses a technique for embedding special identifying signals in audio and TV programs which are reproducible by speakers in radio and television sets as a series of tones, perhaps in a frequency that cannot be heard by the human ear. These tones are detected and stored by a portable device worn by persons within range of the sound of the TV or radio program containing these identification signals. The stored data is subsequently processed, possibly after being uploaded to a central processing facility, to identify the audience members.

Thus, the Examiner points out that Kiewit discloses a technique for identifying the audience members, and Thomas discloses a technique for identifying the program being watched or listened to by the audience. From this the Examiner reaches the following conclusion:

"Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to adapt the teaching of Thomas to Kiewit to monitor what program the audience is watching or listening to."

In the AMENDMENT filed Aug. 12, 2004, applicants pointed out that the Examiner offered no support for making the combination other than to say, in effect, that A is known, B is known, so therefore AB is obvious. However, a showing of motivation to combine the references is required under U.S. law and applicable PTO practice. Why would the combination proposed by the Examiner be obvious, without the benefit of hindsight based on the present invention?

The fact is that Kiewit and Thomas address very different aims using different equipment which is operated in different ways to achieve different results. Thomas expresses no interest in knowing who is in the audience, and the apparatus disclosed therein includes only the TV/radio apparatus and the portable devices worn by the audience. The claimed "stationary means" of the present invention plays absolutely no role in Thomas. As to Kiewit, this reference expresses no interest in knowing what program is being watched or listened to. Nothing whatsoever can be pointed to in either one of these references to indicate some recognition of how the interweaving of program monitoring and audience member identity monitoring can create a very powerful tool. It is only in the present application that this recognition is made.

As pointed out in the AMENDMENT filed Aug. 12, 2004, it is well established based on extensive case law that in order to establish a *prima facie* case of obviousness, three basic criteria must be met, namely,

1. there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings,
2. there must be a reasonable expectation of success, and
3. the prior art references must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art. Even when the combination of the references includes every element of the claimed invention, without a motivation to combine, a rejection based on a *prima facie* case of obviousness was held improper. Al-Site Corp. v. VSI International, Inc., 50 USPQ 2d 161 (Fed. Cir. 1999).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 16 USPQ 2d 1430 (Fed Cir. 1990).

The Examiner's attention is respectfully invited to MPEP §§ 2143, 2143.01, 2143.02, and 2143.03 which discuss various court decisions in which an obviousness rejection based on a combination of references was overturned for lack of motivation.

In the "Response to Arguments" portion of the Final Rejection, the Examiner states that the applicants' arguments are not persuasive because "the motivation is found in Thomas reference for monitoring what program the audience is watching or listening to ..." It is respectfully submitted that this does not provide the requisite motivation.

Kiewit is interested in knowing who is in the audience. Thomas is interested in knowing what program is being watched or listened to. The present invention is the first to recognize that combining the "who" and "what" capabilities creates a different analysis tool for knowing who is watching what program. Thomas certainly does not explicitly provide the motivation to combine the two. Kiewit does its "thing" and Thomas does its "thing". Therefore, the Examiner must be intimating that the requisite motivation is implied in Thomas. How so?

Thomas says nothing about why one would make such a combination. For example, no advantages from such a combination are mentioned, nor are they apparent from Thomas.

Thomas says nothing useful in terms of how one would go about making such a combination work successfully. In order for the present invention to be useful, the data provided by Kiewit must be properly associated with the data provided by Thomas. No such coordination is disclosed or even hinted at in Thomas (nor in Kiewit!). No technical information is disclosed in Thomas (nor in Kiewit!) enabling the two inventions to work properly in tandem. The Examiner apparently just presumes that this is a readily doable task, but again no basis for this has been established.

The Examiner's attention is respectfully directed to the fact that Claim 2 recites not only "who" (i.e. by detecting identification signals) and "what" (i.e. by detecting a surveying code), but also means for "associating said surveying code with said identification signals." Even if by some stretch one could argue that some motivation exists for combining Kiewit and Thomas, the combination would yield one set of data for "who" and one set of data for "what". However, there is still a wide gap remaining to be bridged between providing these two independent sets of data together, as a matter perhaps of "one stop shopping," and the present invention of associating them to each other. The Examiner has not bridged this gap. Thomas most certainly is completely and

utterly lacking in motivation to implement at least this "associating" feature of the present invention. Consequently, it is respectfully submitted that Claim 2 is allowable over the combination of Kiewit and Thomas.

Each of independent claims 2, 16, 21 and 36 is allowable for reasons presented above with respect to Claim 2.

The remaining pending claims are all dependent claims. Each claim is allowable along with the independent claim from which it depends. In addition, each of the dependent claims includes features which serve to even more clearly distinguish the present invention over the applied references.

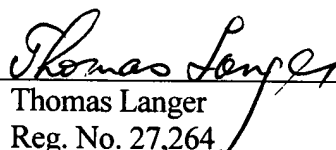
CONCLUSION

Based on all of the above, it is respectfully submitted that the present application is now in proper condition for allowance. Prompt and favorable action to this effect is respectfully solicited.

Should the Examiner have any comments, questions, suggestions or objections, he is invited to telephone the undersigned in order to facilitate reaching a resolution of any such outstanding matters.

Respectfully submitted,

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